

REMARKS***Summary of the Amendment***

Upon entry of the above amendment, claims 15 and 31 will have been amended. Accordingly, claims 1 and 4 – 34 currently remain pending. However, as claims 1 – 14 and 21 – 30, directed to the non-elected invention, have been withdrawn from consideration, only claims 15 – 20 and 31 – 34 are currently under consideration by the Examiner.

Summary of the Official Action

In the instant Office Action, the Examiner has rejected claims 15 – 20 and 31 – 34 based solely upon formal matter, such that these claims would be allowable if presented to overcome this formal rejection. By the present amendment and remarks, Applicants submit that the rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

Amendment is Proper for Entry

Applicants submit, as the instant amendment is directed merely to formal matters (which is the only issue remaining in this application) so as to clarify previously recited claim terminology, no new issues requiring further search are raised in considering the instant amendment nor is any question of new matter raised. The instant amendment merely clarifies the term “combining device,” as recited in independent claims 15 and 31.

Moreover, as no art has been applied against the pending claims, Applicants submit addressing and overcoming the formal rejection will result in

the allowance of the pending claims. Thus, for this additional reason, entry and consideration of this amendment is proper and therefore requested.

Acknowledgment of Telephonic Interview with Examiner Walls-Mayes

Applicants gratefully acknowledge the courtesy extended to their representative by Examiner Walls-Mayes in conducting a telephonic interview on October 31, 2006. In the interview, the formal rejection was discussed. The Examiner was concerned that the term "combining device" was not found in the original disclosure. In response, Applicants' representative agreed the term "combining device" was not expressly included, however, the original disclosure discusses insertion wheel 19 and/or transfer conveyor 20, and Figure 2 further illustrates these elements individually or together *combine* the part groups 7 and 8 in such a manner that the part groups adjoin each other in a lengthwise axial manner to form filter rod 38.

While essentially agreeing with Applicants' arguments, the Examiner was still hesitant to withdraw the rejection because the term "combining device" was not found. Applicants indicate they would consider amending the claims to recite a term the Examiner might find more acceptable.

Applicants further requested that the Examiner rejoin and consider the non-elected claims, since the Manual of Patent Examining Procedure [hereinafter "M.P.E.P."] provide clear guidance that the pending claims are eligible for rejoinder. The Examiner requested the relevant portion of the M.P.E.P. be cited in Applicants' response.

Amendment to the Claims and Request for Rejoinder of Non-Elected Claims

Applicants, in amending pending claims 15 and 31, have presented these claims in allowable form. As claims 1, 8, 11, and 21, which have been withdrawn as directed to the non-elected invention, recite processes of making a filter in the allowable apparatus recited in either independent claim 15 or independent claim 31, Applicants submit all of the features of the allowable apparatus are recited in these process claims.

Accordingly, upon allowance of independent claims 15 and 31, Applicants request rejoinder and consideration of withdrawn claims 1 – 14 and 21 – 30, and an indication that these claims are allowable.

In the Examiner's Restriction Requirement, made final in the previous Office Action, the Examiner acknowledges the inventions are related as process (non-elected invention) and apparatus for its practice (elected invention). Section 821.04(a) of the M.P.E.P. provides

where restriction was required between a product and a process of using the product . . . and the product invention was elected and subsequently found allowable, all claims to a non-elected process must depend from or otherwise require all the limitations of an allowable claim for the claims directed to that process invention to be eligible for rejoinder.

M.P.E.P. § 821.04(a), 8th Ed., Rev. 3, p. 800-64 (August 2005).

As each of the non-elected claims 1+, 8+, 11+, and 21+ recite a process of using the allowable apparatus, such that each of these non-elected claims depends from an allowable claim, the claims are eligible for rejoinder. Accordingly, rejoinder of claims 1 – 14 and 21 – 30 and consideration of the merits of the same by the Examiner is requested.

Traversal of Rejection Under 35 U.S.C. § 112, First Paragraph

Applicants traverse the rejection of claims 15 – 20 and 31 – 34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

By the present amendment, Applicants have changed the term “combining device” in independent claim 15 to “a device by which the part groups are arranged in such a manner that the filter segments of the part groups are adjoined in a lengthwise axial manner,” and in independent claim 31 to “device coupled to said separation device by which the part groups are arranged in such a manner that the filter segments of the part groups are adjoined in a lengthwise axial manner.”

As discussed in the interview with Examiner Walls-Mayes, the device can, e.g., be embodied by insertion wheel 19 and/or transfer conveyor 20. Moreover, it is apparent from Figure 2 that through insertion wheel 19 and/or transfer conveyor 20 the part groups 7 and 8 are arranged or combined in such a manner that the filter segments of the part groups are adjoined in a lengthwise axial manner as filter rod 38. Moreover, in view of the Examiner’s hesitancy during the telephone interview, Applicants have used the term “arranged” instead of “combined” in amending the pending claims.

Thus, Applicants submit independent claims 15 and 31, as currently amended, find support in the original disclosure for the device recited in place of the previously recited combining device.

Because the claims are fully supported by the original disclosure, Applicants submit the claims are in compliance with the requirements of 35 U.S.C. § 112, first paragraph. Accordingly, Applicants request the Examiner reconsider and withdraw the pending formal rejection and indicate the claims fully comply with the statute.

Application is Allowable

Thus, Applicants respectfully submit that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and respectfully request the Examiner to indicate allowance of each and every pending claim of the present invention.

Authorization to Charge Deposit Account

The undersigned authorizes the charging of any necessary fees, including any further extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, to Deposit Account No. 19 - 0089 in order to maintain pendency of this application.

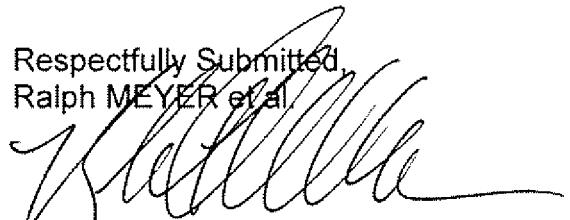
CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicants' invention, as recited in each of claims 15 – 20 and 31 – 34, or as recited in each of the withdrawn claims 1, 4 – 14, and 21 – 30, for which Applicants have requested rejoinder and consideration. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully Submitted,
Ralph MEYER et al.


Neil F. Greenblum
Reg. No. 28,394


Robert W. Mueller
Reg. No. 35,043

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191